

REMARKS

Claims 1, 3-6, and 25-28 are pending and stand rejected. Claims 1, 3, and 25 have been amended herein. Since all of those inventions are reasonably conveyed by the specification and original claims, there is no issue of new matter.

Claims 1, 3-6, and 25-28 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for the reasons set forth in the prior Office Action mailed March 27, 2007. The claims have also been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement for the reasons set forth in the prior Office Action mailed March 27, 2007. Applicants again traverse the rejections.

The Office contends that the pending claims encompass “any chemical compound including any protein and a polypeptide comprising residues 29-766 or 33-766 of SEQ ID NO:2.” Clearly that is not so. Claim 1 recites, in part, “[a] crystal of a polypeptide having the amino acid sequence of residues 29-766 of SEQ ID NO:2.” Similarly, claim 3 recites, in part, “[a] crystal of a polypeptide having the amino acid sequence of residues 33-766 of 766 of SEQ ID NO:2.” Both claims also recite the optional inclusion of a polyhistine tag. Thus, the pending claims do not encompass “any chemical compound including any protein and a polypeptide comprising residues 29-766 or 33-766 of SEQ ID NO:2” as alleged by the Office.

Furthermore, Applicants respectfully submit that the claims are consistent with model claims in the Comparative Study in New Technologies Carried Out Under Trilateral Project WM4. http://www.trilateral.net/projects/biotechnology/protein_3d/. In that report, the USPTO provided its opinion on the patentability of certain claims to a crystalline form of a protein. Case 4 in that Report is drawn to a scenario wherein the

description gave experimental data with explanations of how to make the crystals. The model claim for that case study is as follows:

A crystalline form of protein P having unit cell dimensions of $a=4.0\text{nm}$, $b=7.8\text{nm}$, and $c=11.0\text{nm}$.

The USPTO concluded that such a claim would meet the requirements of enablement, support, clarity, and/or written description.


As in that case study, Applicants have included in the present specification an example of how to make the claimed crystals and included experimental data. Specifically, Example 2 indicates how to prepare and crystallize such crystals, while Example 3 indicates how one skilled in the art may characterize the crystals. Applicants therefore respectfully submit that, by analogy to the case studies presented in the Trilateral Report, the pending claims meet the enablement and written description requirement. Applicants request that the rejection be withdrawn.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims are in condition for allowance. Applicants submit that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner. Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: _____

Lauren L. Stevens

Reg. No. 36,691

Tel: (650) 849-6614

E-mail: lauren.stevens@finnegan.com